



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,749	11/14/2000	Daniel M. LaFontaine	259/012	6224

7590 01/29/2003

David T. Burse  
Bingham McCutchen LLP  
Three Embarcadero Center  
Suite 1800  
San Francisco, CA 94111-4067

EXAMINER

FARAH, AHMED M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/713,749**

Applicant(s)  
**LaFontaine et al.**

Examiner  
**A. Farah**

Art Unit  
**3739**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 12, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 64-84 is/are pending in the application.
- 4a) Of the above, claim(s) 64-69 and 77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 70-76 and 78-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

Art Unit: 3739

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 70-75, 78, 79, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuwirth et al. U.S. Patent No. 5,460,628 in view of Swanson et al. U.S. Patent No. 5,797,903.

Neuwirth et al. disclose an electrosurgical device comprising a catheter (3), an expandable member (5) and an electrode (44). However, they do not particularly teach that their electrode is an RF electrode.

Swanson et al. teach an alternative tissue heating and ablation system and methods using a porous RF electrode assembly with an electrically conductive surface. Therefore, since the use of RF electrodes is well known in the medical field, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Neuwirth et al. with Swanson et al. and use an RF electrode in order to provide the treatment energy.

Art Unit: 3739

3. Claims 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapland et al. U.S. Patent 5,498,238 in view of Swanson et al. '903.

Shapland et al. disclose an electrosurgical apparatus comprising a catheter (11), a porous member (26) attached to the distal portion of the catheter body and an electrode (28).

However, although Shapland et al. use electrode to deliver the treatment energy, they do not teach that their electrode is an RF electrode. Furthermore, they fail to teach that the electrode extending from the distal portion of the catheter.

Swanson et al., described above, teach an alternative surgical apparatus in which the treatment energy is provided by an RF electrode (30). Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify <sup>Shapland</sup>Neuwirth et al. with Swanson et al. and use an RF electrode in order to provide the treatment energy.

As to claim 83, it would have been obvious to one having ordinary skill in the art at the time the invention was made to extend the electrode from the distal portion of the catheter, since it has been held that rearranging parts of an invention involves only routine skill in the art.

4. Claims 76 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuwirth et al. in view of Shapland et al and further in view of Swanson et al.

Art Unit: 3739

Neuwirth teaches all of the limitations of the claims except the use of an RF electrode and an expandable member having a plurality of perforations. Shapland et al. disclose a similar device and teach that it is old and well known in the art to provide perforations on the expandable device such that the heated fluid may pass through the device and directly treat the tissue. Swanson et al. teach the use of an RF electrode to provide the treatment energy. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide perforations on the Neuwirth device so that the fluid could directly treat the tissue. It would have been further obvious to use an RF electrode in order to provide the treatment energy.

### ***Response to Arguments***

5. Applicant's arguments filed on 11/12/2002 have been fully considered but they are not persuasive. The applicant argues that neither Neuwirth et al. nor Shapland et al. use an RF electrode to provide the treatment. As to claim 82, the applicant further argues that the catheter of Shapland et al. lacks a porous member attached to its distal end portion.

As to the first argument, the applicant's original claims fail to recite an RF electrode as presently claimed. Nevertheless, although both Neuwirth et al. and

Art Unit: 3739

Shapland et al. employ electrodes, the applicant's argument is fully considered. As result U.S. Patent 5,797,903 to Swanson et al. is used to obviate the new limitation (i.e., the use of an RF electrode, which provides the treatment energy).

As to the argument that '*the catheter of Shapland et al. lacks a porous member*,' Col. 2, lines 31-36 of Shapland et al. clearly teach that the distal end of the catheter comprises a porous member.

### **Conclusion**

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3739

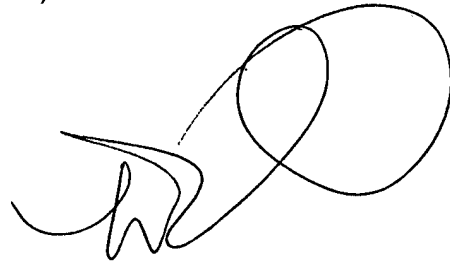
Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

**A. M. Farah**

**Patent Examiner (Art Unit 3739)**



January 27, 2003



**Linda C. M. Dvorak**

**Supervisory Patent Examiner**